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Paper No. 8
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bijoux International, Inc.

Serial No. 75/542,447

Myron Amer, P.C. for Bijoux International, Inc.

Angela M. Micheli, Trademark Examining Attorney, Law Office 108 (David E. Shallant, Managing Attorney).

Before Cissel, Hairston and Holtzman, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Bijoux International, Inc. to register the mark EXTREME SPORT for "all purpose sport bags and fanny packs, backpacks, duffel bags, travel bags, tote bags, handbags, and luggage."[1]

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act on the

[1] Serial No. 75/542,447 filed August 25, 1998, based on applicant's assertion of a bona fide intention to use the mark in commerce.

ground that applicant's mark, if used in connection with the identified goods, would so resemble the previously registered mark EXTREME for "backpacks,"[2] as to be likely to cause confusion. In addition, the Examining Attorney has made final a requirement that applicant disclaim the word SPORT apart from the mark as shown.

Applicant has appealed. Briefs have been filed, but no oral hearing was requested.

We turn first to the disclaimer requirement. It is the Examining Attorney's position that the word SPORT, as used in connection with all purpose sport bags, fanny packs and the like describes a feature or use of the goods and thus, it must be disclaimed. In support of her position, she has submitted several registrations for marks which include the word SPORT, wherein SPORT is disclaimed, for goods of the type involved in this appeal. Applicant, on the other hand, maintains that its mark EXTREME SPORT is a unitary term and thus, a disclaimer is unnecessary.

TMEP Section 1213.06(a) states, in pertinent part, that:

> A mark or portion of a mark is considered "unitary" when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they

[2] Registration No. 1,292,277 issued August 28, 1984; Section 8 & 15 affidavit filed.

> cannot be divided to be regarded as separable elements. If the matter comprising the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic, or otherwise is required.

In this case, we agree with applicant that its mark EXTREME SPORT is a unitary mark and thus, a disclaimer of SPORT is unnecessary. The term "extreme sport" refers to a non-traditional type sport, such as mountain climbing, hang gliding, or motor cross.[3] Applicant's mark EXTREME SPORT is very different from the marks in the third-party registrations relied on by the Examining Attorney wherein the word SPORT is combined with a trade name, e.g., SIERRA SPORT and REGATTA SPORT. In those situations, the trade name and the word SPORT are regarded as separable elements. However, because applicant's mark EXTREME SPORT creates a commercial impression which is separate from that created by the word SPORT alone, a disclaimer is not required in this case.

We turn next to the refusal to register under Section 2(d) of the Trademark Act.

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[3] We take judicial notice of The American Heritage Dictionary of the English Language (4th ed. 2000) wherein "**extreme**" is defined at no. 5 as:

> *Sports* a. Very dangerous or difficult: "extreme skiing." b. Participating or tending to participate in a very dangerous or difficult sport: "an extreme skier."

At the outset, we note that the goods of applicant and registrant are identical in part (backpacks). The rest of applicant's goods are closely related to registrant's backpacks in that they are all items for carrying one's belongings. Applicant does not take issue with the fact that the respective goods are in part identical and are otherwise closely related in that they would be sold in the same channels of trade to the same classes of purchasers. We will focus, therefore, as have applicant and the Examining Attorney, on the involved marks.

As our principal reviewing court, the Court of Appeals for the Federal Circuit, has stated, "When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In this case, applicant seeks to register the mark EXTREME SPORT, while the cited mark is EXTREME. We find that, when considered in their entireties, there are obvious similarities in sound and appearance between the marks. The EXTREME portion of applicant's mark is identical to the entirety of registrant's mark, and the addition of SPORT in applicant's mark as insufficient to avoid a likelihood of

confusion when the marks are applied to identical and closely related goods. The word SPORT is descriptive of applicant's goods in that, as even applicant acknowledges, it indicates that such goods are of a "sport" type or for sport use. If applicant were to use its EXTREME SPORT mark in connection with goods which are identical and closely related to registrant's, purchasers are likely to believe that EXTREME SPORT is a new line of sport backpacks and other products from the makers of EXTREME backpacks.

In finding that applicant's mark is similar to registrant's mark, we have kept in mind the normal fallibility of human memory over time and the fact that purchasers retain a general, rather than a specific, recollection of trademarks encountered in the marketplace. Another factor we have considered is that the record is devoid of any evidence of third-party uses and/or registrations of EXTREME marks for goods similar to the types of goods involved in this appeal.

We conclude that consumers familiar with registrant's backpacks sold under its mark EXTREME would be likely to believe, upon encountering applicant's mark EXTREME SPORT for identical and closely related goods, that the goods originated with or were somehow associated with the same entity.

Decision: The requirement for a disclaimer of SPORT is reversed. The refusal to register under Section 2(d) of the Trademark Act is affirmed.